REMARKS

The Examiner is thanked for the performance of a thorough search, and for considering the references submitted by the Applicants in the Information Disclosure Statements filed on December 30, 2004, November 15, 2004, and September 27, 2004.

No claims have been amended, added, or cancelled. Hence, Claims 1-4, 6-10, 12-17, 19-20, and 23-28 are pending in the application.

I. SUMMARY OF THE REJECTIONS

Claims 1-3, 6-10, 12-16, 19-20, and 23-28 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,012,098 issued to Bayeh et al. ("BAYEH") in view of U.S. Patent No. 6,589,291 issued to Boag et al. ("BOAG"), further in view of U.S. Patent No. 6,480,860 issued to Monday ("MONDAY"), and further in view of U.S. Patent No. 6,480,860 issued to Hill et al. ("HILL").

Claims 4 and 17 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over BAYEH in view of BOAG, further in view of MONDAY, further in view of HILL, and further in view of Karanjit Siyan, *NetWare TCP/IP and NFS*, New Riders Publishing 1994, pp. 11, 94, 103 ("SIYAN").

II. REJECTIONS BASED ON THE CITED ART

A. INDEPENDENT CLAIMS 1, 8, 12, AND 14

Claims 1, 8, 12, and 14 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over BAYEH in view of BOAG, further in view of MONDAY, and further in view of HILL.

1. There is no suggestion or motivation to combine BAYEH with BOAG, MONDAY, and HILL because the combination of BAYEH with BOAG would change the principle of operation of BAYEH

A combination of references under 35 U.S.C. § 103 that change a principle of operation of a reference or would render it inoperable cannot support a 35 U.S.C. § 103 rejection. *See In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); MPEP §2143.01.

The Office Action asserts that it uses BAYEH as the primary reference in the rejections of Claims 1, 8, 12, and 14. In page 4, the Office Action further states that

> It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the invention of Bayeh et al. with that of Boag et al. because such a combination would allow dynamic determination of the most appropriate location for applying style sheets (first sentence of Boag et al.'s Abstract) used by the rendering servlet for parsing the XML data stream (last sentence of Bayeh et al.'s Abstract).

The Applicants respectfully disagree that there is a suggestion or motivation to combine BAYEH with BOAG because such combination would change the principle of operation of BAYEH.

BOAG provides "a technique for dynamically determining the most appropriate location to apply style sheets, whether that location is the client device, the server, or some combination thereof." (BOAG, col. 4, lines 11-14.) BOAG further states in col. 4, lines 30-36, that

> The technique comprises: selecting one or more style sheets to transform a particular input document; **determining whether a client device is capable of applying the selected style sheets**; **applying the selected style sheets at the client device when the determining has a positive result**; and applying the selected style sheets at a server when the determining has a negative result. (Emphasis added.)

Thus, the technique described in BOAG requires that: (1) a determination be always made whether to apply a style sheet to an input document at the client device or at the server, and (2)

if a determination is made that the client device is capable of applying the style sheet, then the client device, and NOT the server, applies the style sheet to the input document.

On the other hand, in its FIG. 4, BAYEH depicts a system in which data servlet 83 retrieves data from a database, and formats the data into an XML data stream 97. The XML data stream 97 is then passed to rendering servlet 85. Rendering servlet 85 uses an XSL style sheet 99 to format the XML data stream 97 into an HTML data stream 96, which is sent to a browser 76 at the client 78. (See also col. 8, line 3 to col. 9, line 24).

Significantly, in col. 11, lines 35-43 BAYEH expressly states that:

> According to the preferred embodiment, ***the rendering servlet must parse the XML data stream, and reformat it into HTML***. This is ***necessary*** because browsers, by convention, expect to receive data that has been formatted with HTML. ***As discussed previously, this parsing process requires two types of data input: the XML data stream, and style sheet information***. (Emphasis added.)

Thus, the technique described in BAYEH expressly teaches that the rendering servlet NECESSARILY MUST parse the XML data stream, which is received from the data retrieval servlet. Further, the above passage (referring to the passage in col. 8, line 66 to col. 9, line 9) also expressly states that the parsing process REQUIRES two types of data input: the XML data stream and style sheet information.

Thus, the system in BAYEH operates on the principle that the rendering servlet, which is different from the client browser (see BAYEH, FIG. 4), NECESSARILY MUST apply the style sheets to the XML data stream.

Suppose now that the technique of BOAG is applied to the system in BAYEH. According to BOAG's technique, the rendering servlet of BAYEH would NOT perform any rendering or formatting of the XML data stream by applying a style sheet to it when the client browser is capable of applying the style sheets. In this case, the rendering servlet would have to

pass the XML data stream to the client browser without any formatting. This, however, clearly violates and changes the principle of operation of BAYEH, which requires that the rendering servlet MUST parse the XML data stream and reformat into an HTML data stream.

Furthermore, BAYEH expressly states that this principle of operation, according to which the rendering servlet necessarily must format the incoming XML data stream into an HTML data stream, is what brings about the advantages of BAYEH's invention. Specifically, in col. 9, lines 18-24, BAYEH states that

> Because the [HTML] data stream 96' received by the [client] browser 76' uses the same formatting instructions supported by existing browser implementations, the processing model defined for the present invention ***minimizes the extent of disruption to existing software by localizing all changes to code running on servers. This minimized disruption further maximizes the advantages of the preferred embodiment.*** (Emphasis added.)

Thus, BAYEH expressly and unambiguously states that the advantages of BAYEH's system are directly dependant on the requirement that the rendering servlet must convert the XML data stream into an HTML stream by applying a style sheet. However, when the rendering servlet is changed so that it does not format the XML data stream as per the technique of BOAG, the resulting system would not provide the express advantages touted by BAYEH. For this reason, one of ordinary skill in the art would not consider it obvious to combine the technique of BOAG with the system in BAYEH because the resulting system would not provide the advantages expressly stated by BAYEH.

For the above reasons, the Applicants respectfully submit there is no suggestion or motivation to combine BAYEH with BOAG because such combination would change the principle of operation of BAYEH.

2. There is no suggestion or motivation to combine BAYEH with BOAG, MONDAY, and HILL because the combination of BAYEH with BOAG would render BAYEH inoperable

As discussed above, BAYEH expressly requires that the XML data stream produced by the data retrieval servlet MUST be converted into an HTML data stream before sending it to the client browser. BAYEH also expressly states that the HTML data stream is created based on two inputs: the XML data stream received from the data rendering servlet, and an XSL style sheet. (col. 8, line 66 to col. 9, line 9). Further, BAYEH expressly shows in FIG. 4 that the XSL style sheets are stored in a database that is accessible by the rendering servlet.

As also discussed above, the technique in BOAG requires that a determination be always made whether to apply a style sheet to an input document at the client device or at the server, and that if the client device is capable of applying the style sheets, then the client device, and NOT the server, applies the style sheet to the input document.

Suppose, however, that the technique of BOAG is applied to BAYEH's system. According to BOAG's technique, when the client device is capable of applying a style sheet, then the client device, and not the rendering servlet, must apply the style sheet to the XML data stream. Thus, in the hypothetical BAYEH-BOAG system, the rendering servlet must pass an unformatted XML data stream to the client browser. However, the client browser does not have a style sheet with which to format the XML data stream, and the rendering servlet is incapable of passing any style sheets to the client browser (in BAYEH's system the rendering servlet sends to the client browser only an HTML data stream). Thus, the client browser would not know how to convert the XML data stream into an HTML document, and the end result would be that the client browser would not be able to display the data. Thus, the combination of BOAG with BAYEH would render BAYEH inoperable.

For the reasons set forth above, it is respectfully submitted that there is no suggestion or motivation to combine the primary reference BAYEH with BOAG because such combination would violate the principle of operation of BAYEH and would render BAYEH inoperable. Thus, reconsideration and withdrawal of the rejections of Claims 1, 8, 12, and 14 under 35 U.S.C. § 103(a) over BAYEH in view of BOAG, further in view of MONDAY, and further in view of HILL, are respectfully requested.

B. INDEPENDENT CLAIM 8

Claim 8 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over BAYEH in view of BOAG, further in view of MONDAY, and further in view of HILL.

Claim 8 includes the features of:

> wherein **a plurality of mark-up languages are each associated with one or more client device types** of a plurality of client device types;
>
> **selecting**, based on a client device type to which the output is to be sent, **a second mark-up language of said plurality of mark-up languages** that is different than said first mark-up language;

The Applicants respectfully submit that none of BAYEH, BOAG, MONDAY, or HILL describes the features of (1) a plurality of mark-up languages that are each associated with one or more client device types, and (2) selecting, based on a client device type to which the output is to be sent, a second mark-up language of said plurality of mark-up languages.

In page 9, numbered paragraph 10, the Office Action states that the rejection of Claim 8 is based on the rationale of the rejection of Claim 1. Thus, the Office Action does not specify exactly what in BAYEH, BOAG, MONDAY, or HILL corresponds to the feature of Claim 8 of a plurality of mark-up languages that are each associated with one or more client device types.

It seems that the Office Action analogizes the style sheets, which are used in HILL to adapt the content of a document to a particular monitor or display, to the plurality of mark-up languages recited in Claim 8. The Applicants respectfully submit that this analogy is incorrect.

First, the Applicants respectfully submit that style sheets and markup-languages are two distinct and separate concepts that are not equivalent. For example, in col. 2, lines 22-28, BOAG states:

> Style sheet languages such as XSL, along with their associated processors, are powerful tools for filtering data content encoded in notations such as XML, as well as for transforming documents encoded into other markup languages such as HTML (HyperText Markup Language) or WML (Wireless Markup Language).

Thus, while the above passage may be showing that style sheets may be used for transforming documents from one mark-up language to another, the above passage also makes it clear that style sheets are not equivalent to mark-up languages.

Second, contrary to the implicit assertion in the Office Action, HILL does not describe that a plurality of mark-up languages are each associated with one or more client device types. In the passage in col. 11, lines 4-23, which the Office Action asserts as showing a plurality of mark-up languages, HILL states that

> The document, the layout generator and the style sheets may be created by the author. The author may create a layout generator which selects **a different style sheet for each type of display**. Alternatively, the author may create a layout generator which selects **the same style sheet for all display devices** with capabilities within a predetermined range. For example, **the author may determine that a style sheet entitled "High Resolution" may be used for all display devices with resolutions within a first predetermined range, a style sheet entitled "Medium Resolution" may be used for all display devices with resolutions within a second predetermined range, and a style sheet entitled "Low Resolution" may be used for all other display devices.** An authoring tool may assist the author in creating the layout generator and the style sheets. The layout generator may be designed to work with a particular document and a particular set of style sheets or style definitions. Alternatively, the layout generator may be a general purpose layout generator which is

> designed to work with multiple documents and different sets of style sheets or style definitions. (Emphasis added.)

Thus, while the above passage may be showing that a different style sheet may associated with a monitor or display of a different resolution, the Applicants find nothing in this passage to suggest that a different **mark-up language** is associated with each of the displays based on the display resolution. Furthermore, the Applicants cannot find any other passage in HILL which suggests that a **mark-up language** may be associated with the type of the display or monitor that is used by the client.

In contrast, Claim 8 recites the feature of **a plurality of mark-up languages that are each associated with one or more client device types** of a plurality of client device types. Furthermore, since HILL does not show the feature of a plurality of mark-up languages, HILL cannot possibly show the feature of Claim 8 of **selecting**, based on a client device type to which the output is to be sent, **a second mark-up language of said plurality of mark-up languages** that is different than said first mark-up language.

For these reasons, the Applicants respectfully submit that BAYEH, BOAG, MONDAY, and HILL, when taken separately or in combination, fail to describe all features of Claim 8. Thus, reconsideration and withdrawal of the rejection of Claim 8 under 35 U.S.C. § 103(a) over BAYEH in view of BOAG, further in view of MONDAY, and further in view of HILL, is respectfully requested.

C. DEPENDENT CLAIMS 2-4, 6-7, 9-10, 13, 15-17, 19-20, AND 23-28

Each of Claims 2-4, 6-7, 9-10, 13, 15-17, 19-20, and 23-28 is dependent upon one of independent Claims 1, 8, 12 and 14, and thus includes each and every feature of its corresponding independent claim. Each of Claims 2-4, 6-7, 9-10, 13, 15-17, 19-20, and 23-28 is therefore allowable for the reasons given above for Claims 1, 8, 12 and 14. In addition,

each of Claims 2-4, 6-7, 9-10, 13, 15-17, 19-20, and 23-28 introduces one or more additional features that independently render it patentable. However, due to the fundamental differences already identified, to expedite the positive resolution of this case a separate discussion of these features is not included at this time. Therefore, it is respectfully submitted that Claims 2-4, 6-7, 9-10, 13, 15-17, 19-20, and 23-28 are allowable for the reasons given above with respect to Claims 1, 8, 12 and 14.

III. CONCLUSION

The Applicants believe that all issues raised in the Office Action have been addressed. Further, for the reasons set forth above, the Applicants respectfully submit that allowance of the pending claims is appropriate. Reconsideration of the present application is respectfully requested in light of the remarks herein.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

To the extent necessary to make this reply timely filed, the Applicant petitions for an extension of time under 37 C.F.R. § 1.136. If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to charge any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,
HICKMAN PALERMO TRUONG & BECKER LLP

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Stoycho Draganoff

Stoycho D. Draganoff
Reg. No. 56,181

2055 Gateway Place, Suite 550
San Jose, California 95110-1089
Telephone No.: (408) 414-1080 ext. 208
Facsimile No.: (408) 414-1076